

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Barsanti et al.
Title: BENZIMIDAZOLE QUINOLINONES AND
USES THEREOF
Appl. No.: 10/644,055
Filing Date: 8/19/2003
Patent No.: 7470709
Grant Date: 12/30/2008
Examiner: D. Margaret M. Seaman
Art Unit: 1625
Confirmation Number: 5144

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 12/30/2008 as U.S. Patent No. 7,470,709.

The Patent Office determined that the patent was entitled to 392 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA

statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicants have recalculated PTA for the captioned patent under the court’s interpretation of the PTA statute, and have determined that the patent is entitled to 811 days PTA, as shown on the attached sheets, which show the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheets detail the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

| | |
|---|-----------|
| (a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): | 1021 days |
| (b) Total Applicant delay: | 210 days |
| Final PTA Determination: | 811 days |

Applicants therefore respectfully request that the patent be accorded 811 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

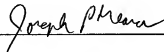
However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Dated: February 25, 2009

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By



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Attorney for Applicant
Registration No. 44,932

CLOSE WINDOW

All Cases - SELECT CASE

Patent Term Adjustment Calculation System

Docket Number: 072121-0307
 Application Number: 10/644055
 Patent Number: N/A

| | Event Description | Event Date | Days from Filing | PTO Days | Applicant Days |
|-------------|---|------------|------------------|----------|----------------|
| Edit Delete | Application Filing Date | 08/19/2003 | 0 | | |
| Edit Delete | Notice to File Missing Parts | 11/17/2003 | 90 | | |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO | 11/17/2003 | 90 | | |
| Edit Delete | Response to Notice to File Missing Parts | 12/11/2003 | 114 | | |
| Edit Delete | Preliminary Amendment under 1.704(c)(6) Received at PTO | 12/15/2003 | 118 | | |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO | 12/22/2003 | 125 | | |
| Edit Delete | Application Is Now Complete | 01/30/2004 | 164 | | |
| | 14 month From Application date | 10/19/2004 | 427 | | |
| Edit Delete | Preliminary Amendment NOT falling under 1.704(c)(6) Received at PTO | 12/15/2005 | 849 | | |
| Edit Delete | Restriction Requirement | 06/13/2006 | 1,029 | 602 | |
| Edit Delete | Restriction Requirement Response Received at PTO | 07/10/2006 | 1,056 | | |
| | 3 Year Period Starts | 08/19/2006 | 1,096 | | |
| Edit Delete | Non-Final Office Action | 09/18/2006 | 1,126 | | |
| | Non-Final Office Action + 3 months | 12/18/2006 | 1,217 | | |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 03/16/2007 | 1,305 | | 88 |
| Edit Delete | Final Office Action | 06/11/2007 | 1,392 | | |
| | Final Office Action + 3 months | 09/11/2007 | 1,484 | | |
| Edit Delete | Request For Continued Examination | 10/12/2007 | 1,515 | | 31 |
| | 3 Year Period Stopped | 10/12/2007 | 1,515 | 419 | |
| Edit Delete | Non-Final Office Action | 12/21/2007 | 1,585 | | |
| | Non-Final Office Action + 3 months | 03/21/2008 | 1,676 | | |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 06/20/2008 | 1,767 | | 91 |
| Edit Delete | Notice of Allowance | 08/15/2008 | 1,823 | | |
| Edit Delete | Issue Fee Paid | 11/12/2008 | 1,912 | | |
| Edit Delete | Patent Grant Date | 12/30/2008 | 1,960 | | |
| | | | Totals: | 1,021 | 210 |
| | | | PTA: | 811 | |



Version: 3.02.05

LOGIN: Sharon Dudley

IP: 10.24.4.200

Foley & Lardner LLP